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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/711,613	09/28/2004	Fred Bishop	54022.3100	5612
20222 7590 11/14/2008 SNELL & WILMER L.L.P. (Main) 400 EAST VAN BUREN ONE ARIZONA CENTER PHOENIX, AZ 85004-2202				
EXAMINER				
TO, BAOQU'OC N				
ART UNIT		PAPER NUMBER		
2162				
MAIL DATE		DELIVERY MODE		
11/14/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/711,613

**Applicant(s)**

BISHOP ET AL.

**Examiner**

BAOQUOC N. TO

**Art Unit**

2162

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 September 2008.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 25-33 and 46 is/are pending in the application.  
4a) Of the above claim(s) 1-25 and 34-45 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 33, 35 and 46 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/55/06)  
Paper No(s)/Mail Date 10/04/2004, 03/28/2005 and 04/30/2008.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_



**DETAILED ACTION**

1. Claims 1-24 are canceled and 25-46 are newly added in the amendment filed on 02/01/2008.

Claims 34-45 are canceled based on the Restriction requirement on 09/03/2008.

Claims 25-33 and 46 are pending in this application.

***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted 03/08/2005. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

M.P.E.P section 2004 (Aids to Compliance With Duty of Disclosure) recites the following:

13. It is desirable to avoid the submission of long lists of documents if it can be avoided. Eliminate clearly irrelevant and marginally pertinent cumulative information. If a long list is submitted, highlight those documents which have been specifically brought to applicant's attention and/or are known to be of most significance. See *Penn Yan Boats, Inc. v. Sea Lark Boats, Inc.*, 359 F. Supp. 948, 175 USPQ 260 (S.D. Fla. 1972), *aff'd*, 479 F.2d 1338, 178 USPQ 577 (5th Cir. 1973), *cert. denied*, 414 U.S. 874 (1974). But cf. *Molins PLC v. Textron Inc.*, 48 F.3d 1172, 33 USPQ2d 1823 (Fed. Cir. 1995).

3. It is noted that the IDS of filed on 10/04/2004 and 08/30/2008 are tenth pages long and represents multiple hundred of pages of highly technical disclosure, which meets the test of a "long list". Moreover, a number of the references do not appear to be material to the patentability of the claimed invention. Therefore, the determination of whether or not references are material to the patentability appears to be an issue. The references cited in the IDS of 10/04/2004 and 04/30/2008 will not be considered until an *underlining* of the most relevant documents is provided, per M.P.E.P. 2004. Please do not delineate the references using a highlighter since the documents will be scanned and the highlighted sections will not be visible. Applicant's forthcoming assistance is gratefully anticipated.

### ***Response to Arguments***

4. Applicant's arguments with respect to claims 25 and 46 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 25-33 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Rau et al. (US. Pub. 2006/0178937 A1) in view of Phillips et al. (US. Patent No. 6,997,378 B2).

As to claim 25, Rau discloses a method of maintaining a merchant system registry file on a merchant system, comprising:

associating a plurality of transaction account records with a plurality of recurring billing account records, wherein the plurality of transaction account records and the plurality of recurring billing account records are part of a billing database, and wherein individual of the recurring billing account records comprises a recurring billing amount; receiving a Radio Frequency (RF) recurring billing request (account table 112) (paragraph 0012);

matching the RF recurring billing request with the corresponding transaction account record and the corresponding recurring billing account record; when the RF recurring billing request is verified based on the billing database, adding the RF

recurring billing request to the corresponding recurring billing amount (if a patron purchases a meal in a restaurant line at point of sale device 108, the total purchase price may be validated against available credit, available cash or other account-specified balance within account table 112 for completion of transaction) (paragraph 0014)

Rau does not explicitly disclose repeatedly submitting the recurring billing amounts to a provider system for payment processing; modifying the merchant system registry file by appending a merchant transaction code to at least one of the plurality of transaction account records; and modifying the merchant system registry file in accordance with a summary report from the provider system. However, Phillips discloses repeatedly submitting the recurring billing amounts to a provider system for payment processing; modifying the merchant system registry file by appending a merchant transaction code to at least one of the plurality of transaction account records; and modifying the merchant system registry file in accordance with a summary report from the provider system ( where a credit card provider has altered a credit card customer's information (e.g., card status, card number or expiration date) the provider may generate a file containing the altered credit card information (step 802). The server 110 may then generate a transaction code for use by the server 110 and/or by the merchant in updating the customer information stored in the merchant's billing database location (step 804). The server may then append the customer information and related transaction code to the maintenance file which may be downloaded to the merchant system (step 806). Upon downloading the maintenance file, the merchant may perform

a sequence of steps designed to insure that the merchant's recurrent billing customer database is updated in accordance with the information contained on the periodic maintenance report (step 806)) (fig. 8). This suggests updating the user register account for a billing summary report include the merchant data. Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention was made to modify teaching of Rau to include updating the user register account for a billing summary report include the merchant data as disclosed by Phillips to allow the user to understand the billing summary report.

As to claim 26, Rau teaches the method of claim 25, wherein the merchant transaction code comprises at least one of an add transaction code, a delete transaction code, and a change transaction code) (modify information within account table 112) (paragraph 0026).

As to claim 27, Rau teaches the method of claim 25, wherein individual of the transaction account records comprises a customer transaction account number, a customer merchant account number, and a customer transaction account expiration date (modify information within account table 112) (paragraph 0026).

As to claim 28, Rau teaches the method of claim 27, wherein the RF recurring billing request is verified based on the customer transaction account expiration date in the billing database on the merchant system) (cash required as indication of verification) (paragraph 0014).



As to claim 29, Rau teaches the method of claim 25, further comprising periodically transmitting the merchant system registry file at a frequency of at least one of once per day, once per week, and once per month) (each transaction) (paragraph 0014).

As to claim 30, Rau teaches the method of claim 25 excepting for receiving the summary report from the provider system, wherein the summary report comprises a plurality of decision codes associated with the plurality of transaction account records transmitted in the merchant system registry file, and wherein the summary report further comprises a rejected record file. However, Phillips discloses receiving the summary report from the provider system, wherein the summary report comprises a plurality of decision codes associated with the plurality of transaction account records transmitted in the merchant system registry file, and wherein the summary report further comprises a rejected record file (where a credit card provider has altered a credit card customer's information (e.g., card status, card number or expiration date) the provider may generate a file containing the altered credit card information (step 802). The server 110 may then generate a transaction code for use by the server 110 and/or by the merchant in updating the customer information stored in the merchant's billing database location (step 804). The server may then append the customer information and related transaction code to the maintenance file which may be downloaded to the merchant system (step 806). Upon downloading the maintenance file, the merchant may perform a sequence of steps designed to insure that the merchant's recurrent billing customer database is updated in accordance with the information contained on the periodic

maintenance report (step 806)) (fig. 8). This suggests updating the user register account for a billing summary report include the merchant data or rejected with merchant data. Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention was made to modify teaching of Rau to include updating the user register account for a billing summary report include the merchant data or rejected with merchant data as disclosed by Phillips to allow the user to understand the billing summary report.

As to claim 31, Rau teaches the method of claim 30 excepting for wherein the summary report further comprises a tally of rejected records. However, Phillips discloses receiving the summary report from the provider system, wherein the summary report comprises a plurality of decision codes associated with the plurality of transaction account records transmitted in the merchant system registry file, and wherein the summary report further comprises a rejected record file (where a credit card provider has altered a credit card customer's information (e.g., card status, card number or expiration date) the provider may generate a file containing the altered credit card information (step 802). The server 110 may then generate a **transaction code** for use by the server 110 and/or by the merchant in **updating** the customer information stored in the merchant's **billing database** location (step 804). The server may then append the customer information and related transaction code to the maintenance file which may be downloaded to the merchant system (step 806). Upon downloading the maintenance file, the merchant may perform a sequence of steps designed to insure that the merchant's recurrent billing customer database is updated in accordance with the

information contained on the periodic maintenance report (step 806)) (fig. 8). This suggests updating the user register account for a billing summary report include the merchant data or all rejected with merchant data. Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention was made to modify teaching of Rau to include updating the user register account for a billing summary report include the merchant data or all rejected with merchant data as disclosed by Phillips to allow the user to understand the billing summary report.

As to claim 32, Rau teaches the method of claim 25, further comprising requesting provider preauthorize of the plurality of transaction account records (authorize for sale) (paragraph 0014).

As to claim 33, Rau teaches the method of claim 25, wherein the modifying of the merchant system registry file comprises manually modifying the merchant system file registry file in accordance with the summary report (modify information within account table 112) (paragraph 0026).

As to claim 46, Rau discloses a method for processing a recurring billing transaction at a merchant system, comprising:

receiving an RF transmission comprising an account code (RF link) (paragraph 0014);

receiving a recurring billing request (same sale for the same register file) (paragraph 0020);

retrieving a recurring billing record associated with the account code from a registry file (update subscriber registration table) (paragraph 0020);

updating the recurring billing record with the recurring billing request, wherein the recurring billing record is stored in the registry file and is associated with the account code (modify the information within account table 112) (paragraph 0026).

Rau does not explicitly disclose repeatedly processing a recurring bill associated with the recurring billing record; verifying the account code with a summary report from a provider; receiving a maintenance file comprising at least one provider-changed account code and a provider transaction code associated with the at least one provider-changed account code; and updating the registry file at the merchant system in accordance with the at least one provider-changed account code and the associated provider transaction code. However, Phillips discloses repeatedly processing a recurring bill associated with the recurring billing record; verifying the account code with a summary report from a provider; receiving a maintenance file comprising at least one provider-changed account code and a provider transaction code associated with the at least one provider-changed account code; and updating the registry file at the merchant system in accordance with the at least one provider-changed account code and the associated provider transaction code (where a credit card provider has altered a credit card customer's information (e.g., card status, card number or expiration date) the provider may generate a file containing the altered credit card information (step 802). The server 110 may then generate a transaction code for use by the server 110 and/or by the merchant in updating the customer information stored in the merchant's billing

database location (step 804). The server may then append the customer information and related transaction code to the maintenance file which may be downloaded to the merchant system (step 806). Upon downloading the maintenance file, the merchant may perform a sequence of steps designed to insure that the merchant's recurrent billing customer database is updated in accordance with the information contained on the periodic maintenance report (step 806)) (fig. 8). This suggests updating the user register account for a billing summary report include the merchant data or all rejected with merchant data. Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention was made to modify teaching of Rau to include updating the user register account for a billing summary report include the merchant data or all rejected with merchant data as disclosed by Phillips to allow the user to understand the billing summary report.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Contact Information***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Baoquoc N. To whose telephone number is at 571-272-4041, or unofficial fax number for the purpose of discussion (571) 273-4041 or via e-mail BaoquocN.To@uspto.gov. The examiner can normally be reached on Monday-Friday: 8:00 AM – 4:30 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached at 571-272-4107.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Any response to this action should be mailed to:  
Commissioner of Patents and Trademarks  
Washington, D.C. 20231.

The fax numbers for the organization where this application or proceeding is assigned are as follow:

(571) 273-8300 [Official Communication]

/Baoquoc N To/  
Primary Examiner, Art Unit 2162  
November 8th, 2008